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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,940	04/14/2004	Tatsuya Kuroda	09792909-5866	5280

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EXAMINER
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SARPONG, AKWASI

ART UNIT	PAPER NUMBER
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4178

MAIL DATE	DELIVERY MODE
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12/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,940	<b>Applicant(s)</b> KURODA ET AL.	
	<b>Examiner</b> AKWASI M. SARPONG	<b>Art Unit</b> 4178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/03/2006 and 12/12/2007</u> .                               | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 claims “a program ...” However, the claims do not define a program to be a functional descriptive material encoded on a memory/disk/computer-readable medium, and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized”). Moreover, a “program” is neither a process (“action”), nor machine, nor manufacture, nor composition of matter (i.e., tangible “thing”) and therefore non-statutory.

Such claimed “program” (software) does not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program’s functionality to be realized. As such, “program”/software, not claimed as embodied/encoded in computer-readable medium and is not statutory because the “program”/software is not capable of causing functional change in the computer. Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory and appears to be one type of claim that is considered nonstatutory, under the present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

The Examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as signals, carrier waves, etc...

Any amendment to the claim should be commensurate with its corresponding disclosure.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-7** are rejected under 35 U.S.C. 102(b) as being anticipated by Barrett (5301036).

**Claim 1**, Barrett disclose a print terminal (Col. 2, Lines 26-40, Fig. 1) comprising:  
an image-capturing unit for capturing image data (Fig. 2, El. 4, Col. 2 Lines 35-45)

a first rotation-processing unit for rotating a print image to be used in printing the image data captured by the image-capturing unit (Col. 5, Lines 10-35, Fig. 2, El. 58).

a second rotation-processing unit for rotating a print- medium image to change the orientation of a print medium to be used in printing the image data captured by the image- capturing unit (Col. 8, Lines 34-60, Fig. 9 El. 216, 222 and 224-Thus doing duplex changes the orientation of document or paper); and

a third rotation-processing unit for simultaneously rotating both the print image and the print-medium image (Col.10, Lines 8-26, Fig. 11-thus for the device to output the desired document, the processor has to rotate both the image and the medium as soon in Fig. 11 from Column III to IV).

**Claim 2**, Barrett discloses a print terminal, wherein the third rotation-processing unit rotates the print image and the print-medium image by 90 degrees (Col. 8 Lines 8-20, Fig. 11).

**Claim 3**, Barrett discloses all the limitations in Claim as discussed above.

Barrett does not disclose a print terminal wherein the first rotation-processing unit rotates the print image by 90 degrees (Col. 8 Lines 8-20, Fig. 11).

**Claim 4**, Barrett discloses a print terminal that further comprising a reader for reading the image data from a recording medium, wherein the image-capturing unit captures the image data read by the reader. (Col. 4 Lines 30-35, Fig.2 El. 50).

**Claim 5**, Barrett discloses a print system (Col. 3 Lines 26-30, Fig. 1) comprising:  
a print terminal (Col. 2 Lines 25-40, Fig. 2 El. 8) including  
an image-capturing unit for capturing image (Col. 2, Lines 25-40, Fig. 2 El. 4)  
data;

a first rotation-processing unit for rotating a print image to be used in printing the image data captured by the image-capturing unit (Col. 5, Lines 10-35, Fig. 2, El. 58).

a second rotation-processing unit for rotating a print-medium image to change the orientation of a print medium to be used in printing the image data captured by the image-capturing unit (Col. 8, Lines 34-60, Fig. 9 El. 216, 222 and 224-Thus doing duplex changes the orientation of document or paper); and

a third rotation-processing unit for simultaneously rotating both the print image and the print-medium image (Col.10, Lines 8-26, Fig. 11-thus for the device to output the desired document, the processor has to rotate both the image and the medium as seen in Fig. 11 from Column III to IV).

and a printer for printing the image data processed by the print terminal on the print medium (Col. 3 Lines 55-65, Fig. 2 El. 8).

**Claim 6**, Barrett discloses a computer-readable storage medium storing a program (Fig. 2 El. 25a, 54 and 128) for implementing the functions comprising:

an image-capturing function for capturing image data (Col. 2, Lines 25-40, Fig. 2 El. 4);

a first rotation-processing function for rotating a print image to be used in printing the image data captured by the image-capturing function ( Col. 5, Lines 10-35, Fig. 2, El. 58).

a second rotation-processing function for rotating a print-medium image to change the orientation of a print medium to be used in printing the image data captured

by the image-capturing function (Col. 8, Lines 34-60, Fig. 9 El. 216, 222 and 224-Thus doing duplex changes the orientation of document or paper)

a third rotation-processing function for simultaneously rotating both the print image and the print-medium image (Col.10, Lines 8-26, Fig. 11-thus for the device to output the desired document, the processor has to rotate both the image and the medium as seen in Fig. 11 from Column III to IV).

**Claim 7**, Barrett discloses a program for enabling computers to implement the functions comprising:

an image-capturing function for capturing image data (Col. 2, Lines 25-40, Fig. 2 El. 4).

a first rotation-processing function for rotating a print image to be used in printing the image data captured by the image-capturing function ( Col. 5, Lines 10-35, Fig. 2, El. 58).

a second rotation-processing function for rotating a print-medium image to change the orientation of a print medium to be used in printing the image data captured by the image-capturing function (Col. 8, Lines 34-60, Fig. 9 El. 216, 222 and 224-Thus doing duplex changes the orientation of document or paper)

a third rotation-processing function for simultaneously rotating both the print image and the print-medium image (Col.10, Lines 8-26, Fig. 11-thus for the device to output the desired document, the processor has to rotate both the image and the medium as seen in Fig. 11 from Column III to IV).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AKWASI M. SARPONG whose telephone number is (571)270-3438. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HAI Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMS  
12/13/2007

/Hai Tran/  
Supervisory Patent Examiner, Art Unit 4178